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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/621,389	07/18/2003	Noriyuki Koike	0171-0994P	2460

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BIRCH STEWART KOLASCH & BIRCH
PO BOX 747
FALLS CHURCH, VA 22040-0747

EXAMINER

WU, IVES J

ART UNIT	PAPER NUMBER
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1724

DATE MAILED: 07/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/621,389

Applicant(s)

KOIKE ET AL.

Examiner

Ives Wu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-4, 6 and 7 is/are rejected.
- 7) ☒ Claim(s) 5 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/22/03</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

(1). Applicants' Amendments and Remarks filed on June 16, 2006 have been received and acknowledged.

Claim 1 is amended. Claims 5-7 are newly added.

The rejections of claims 1-4 in the prior Office Action dated March 16, 2006 is sustained and presented with rejection of claims 5-7 in the succeeding paragraphs.

Claim Rejections - 35 USC § 103

(2). The text of those Section Title 35 U. S. Code not included in this Office Action can be found in the prior Office Action dated March 16, 2006.

(3). **Claims 1 ~ 4, 6 ~ 7** are rejected under 35 U.S.C. 103(a) as being unpatentable over Fukuda et al (US006040400A) in view of Maxson et al (US005665794A).

(4). The same rationale of rejection for claims 1-4 is recited in the prior Office Action dated March 16, 2006.

(5). As to limitation of **claim 6**, Maxson et al (US005665794A) disclose the substituent R^f being a perfluoroalkylethyl radical and the perfluoroalkyl portion of R^f can contain from one to about 10 carbon atoms. R^f can be, for example, perfluoromethyl, perfluoroethyl, perfluorobutyl and perfluorooctyl. Preferred is when R^f is 3,3,3-trifluoropropyl (Col. 3, line 9-15). The 3,3,3-trifluoropropylethyl radical meets the $CF_3(CF_2)_xCH_2CH\cdot$ where $x = 0$.

As to limitation of **claim 7**, Fukuda et al disclose the amount of the organosilicon compound to be mixed such that the hydrosilyl groups, or SiH groups, contained in the component are preferably 0.2 to 2.0 mole per mol of aliphatic unsaturated groups such as vinyl group (Col. 8, line 34-38).

Allowable Subject Matter

(6). **Claim 5** is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments filed on June 16, 2006 have been fully considered but they are not persuasive.

Applicants' main issue is both the component (A) and component (B) in the instant claim 1 are now limited by "consisting of" to exclude other components such as component B of prior reference Fukuda et al (US006040400) and the other alkylhydrogensiloxane crosslinker of prior art reference Maxson et al (US005665794A). Therefore, the combined teaching of Maxson et al (US005665794A) and Fukuda et al (US006040400A) would not meet the inventive subject as claimed by applicants. However, the word "comprising" recited in the claim 1 is open language allowing other uncited components in the curable fluoropolyether composition as claimed by applicants.

As to the 2nd issue that the product Fukuda et al (US006040400A) is gel, not rubber, however, the combined teaching of Fukuda et al (US006040400A) and Maxson et al (US005665794A) meets the requirements of instant claim 1, therefore, it is reasonable to believe that the product of combined teaching would be a rubber.

Presently, claims 1-7 are pending.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ives Wu whose telephone number is 571-272-4245. The examiner can normally be reached on 8:00 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Duane Smith can be reached on 571-272-1166. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Examiner: Ives Wu

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Date: July 8, 2006

DUANE SMITH
PRIMARY EXAMINER

D-S
7-10-06